

REMARKS

Applicants respectfully request reconsideration of the present application and pending claims in view of the claim amendments and the following remarks.

Claims 1-10, 13-29, and 31-37 are pending. Claims 1-10 and 36 are rejected as being unpatentable under 35 U.S.C. §103 based upon a combination of Cho in view of Bosley, Hibbs, Hobbs, and Sarkis. Applicants respectfully traverse.

There is agreement that the primary reference Cho, although disclosing a guide catheter, fails to disclose a distal tip that is both radio-opaque and echogenic. Bosley, therefore, is relied upon for its disclosure of a device that is both ultrasonically imageable and radiographically imageable. However, Bosley achieves that objective by the use of glass spheres for echogenicity and, in addition, finely ground tungsten powder for radiopacity. As previously pointed out by Applicants, a distal tip that is both radio-opaque and echogenic is realized according to present invention by use of a single material, tungsten carbide particles of a particular size and distribution, that are distributed within the polymeric material that forms the distal tip.

In response to Applicants' arguments, the examiner contends in the advisory action that the scope of rejected claim 1 may include both glass beads and tungsten particles as taught by Bosley. Accordingly, claim 1 has been amended to make clear that a distal tip that is both radio-opaque and echogenic is realized by use of a single material, tungsten carbide particles that are distributed within the polymeric material that forms the distal tip. Thus, regardless of whether the examiner's contention that Bosley makes obvious the addition of both glass and tungsten in the material of the guide catheter of Cho to make it both radio-opaque and echogenic is correct or not, amended claim 1 requires that a single material in the distal tip material imparts both radiopacity and echogenicity. The obviousness rejection is thereby obviated.

An additional contention made by the examiner is that Sarkis teaches that addition to a rubber material of particles with a specific gravity of 5 or greater (e.g., iron oxide and zinc oxide) and sized less than 500 nanometers provides echogenic properties to the material. Then, the further contention is made that, in view of such teaching of Sarkis, use of such particles rather than glass spheres to make the polymeric material of Bosley echogenic would be obvious. From these two contentions, the examiner concludes that it would therefore be obvious to follow Sarkis' teaching to result in a distal tip in Cho that is both echogenic and radiopaque using a single material, which could be tungsten carbide.

However, what the examiner ignores is that Sarkis, like Bosley, teaches to *use two separate materials*, one that is echogenic and one that is radiopaque.

See col. 5, lines 52-56:

FIG. 12 illustrates the overall method of use of the device according to the present invention. In this case, a pacing lead 110 is shown being placed within the heart 112 of a patient 114 while being monitored ultrasonically. The distal portion 116 of the lead is provided with a coating of echogenic material or is fabricated of echogenic material according to the present invention, rendering it visible on ultrasound imaging system 118. *The echogenic material according to the present invention may thus be usefully **substituted for or used in addition to radiopaque materials typically employed** to increase the fluoroscopic visibility of medical devices within the human body.*

Thus, Sarkis, contrary to the examiner's contention in the advisory action, does not support use of a single material to provide both echogenic and radiopaque properties to the distal tip of Cho's guide catheter. Instead, Sarkis teaches away from the claimed subject matter. The fundamental premise of the obviousness rejection is flawed.

Given the misunderstanding of Sarkis, as evidenced by the examiner's contentions in the advisory action, the scope and content of the prior art is mischaracterized and inaccurate. The requisite combination of limitations of amended claim 1, as a whole, remains unmet by the scope and content of the

prior art combination of Cho/Bosley/Hobbs/Sarkis/Hibbs relied upon in the obviousness rejection being advanced. Under Graham v. Deere, the obviousness rejection is therefore without merit and should be withdrawn.

Clearly, the examiner's response in the advisory office action does not yield a showing of the obviousness of claimed subject matter as contended. Instead, by following the teachings of Bosley and Sarkis, what results is a device that is both ultrasonically imageable and radiographically imageable only because separate echogenic and radiopaque materials are used. That is not the claimed subject matter of amended claim 1. Because assembling a device in accordance with the combination of teachings of Cho, Bosley, Hobbs, Hibbs and Sarkis does not result in the claimed subject matter, as a whole, of amended claim 1, the obviousness rejection cannot stand.

Claims 13, 14, 23, 24, 31-35, and 37 were rejected as being obvious over the same combination of references as applied to claim 1 and further in view of Wijayarathna. Given the failure of the combination of references applied against amended claim 1 to present a meritorious obviousness rejection, the rejection of claims 13, 14, 23, 24, 31-35, and 37 must also necessarily fail as well.

In summary, following the teachings of Bosley and Sarkis in modification of Cho does not result in the claimed subject matter of amended claim 1 and the dependent claims. Withdrawal of the rejections and issuance of a Notice of Allowance is warranted based upon the amended claim and the remarks.

Respectfully submitted,

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